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In re Application of :
JAMIESON et al : Decision on Petition
Serial No.: 10/055,713 :
Filed : 22 January 2002 :
Attorney Docket No.: 8325-0026 :

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 25 September 2006. The delay in acting upon this petition is regretted.

BACKGROUND

The petition filed under 37 CFR 1.144 requests reconsideration of the restriction requirement mailed 5 May 2005. The restriction requirement mailed 5 May 2005 divided the pending claims 1-4, 6-11, 14, 17-19 and 21-23 into 18 groups.

Applicants elected Group IX with traverse. The examiner considered the traversal and made the restriction requirement final in the Office action mailed 25 August 2005. This petition was filed 25 September 2006, before the filing of a Notice of Appeal and is thus considered timely.

DISCUSSION

The petition and file record have been considered carefully. A review of the file shows that Applicants are petitioning the second of two restriction requirements made in this application.

The first restriction requirement divided claims 1-20 into eleven groups. Applicants elected one of the inventions, with traverse and canceled claim 20. In the first Office action on the merits mailed 6 October 2003, the examiner withdrew the restriction requirement, as follows:

Applicant's election with traverse of Group X, filed July 14, 2003, is acknowledged.

Upon further consideration the restriction requirement is withdrawn. Claims 1-19 are examined in the instant office action.

Claims 1-19 were examined on the merits in the first Office action mailed 6 October 2003 and in the final Office action mailed 8 March 2004.

A comparison of claims which had already been examined shows that the current claims are not directed to patentably distinct inventions from those which had already been examined together.

Relevant claims, pending on 17 December 2003.

1. (currently amended) A non-naturally-occurring protein comprising a modified plant zinc finger protein (ZFP), wherein the zinc finger protein is engineered to bind that binds to a target sequence.

17. (currently amended) An isolated polynucleotide encoding a modified plant zinc finger protein according to claim 1 that binds to a target sequence.

18. (original) An expression vector comprising the isolated polynucleotide of claim 17.

19. (original) A host cell comprising the isolated polynucleotide of claim 17.

14. (previously presented) The isolated polynucleotide of claim 17 further encoding a functional domain.

Relevant claims, pending on 18 August 2006

1. (currently amended): A non-naturally-occurring protein comprising a modified plant zinc finger protein (ZFP), the modified plant ZFP having a modified amino acid sequence as compared to a naturally occurring plant ZFP and comprising a tandem array of a plurality of zinc fingers, each zinc finger comprising a recognition region and a backbone region, wherein

- (i) there are between about 5 and 50 amino acids in the backbone region of each zinc finger and ~~wherein the backbone region is not derived from zif268 or Xenopus TFIIIA~~; and
- (ii) the modified plant zinc finger protein is engineered to bind to a target sequence.

17. (previously presented) An isolated polynucleotide encoding a modified plant zinc finger protein according to claim 1.

18. (original) An expression vector comprising the isolated polynucleotide of claim 17.

19. (original) A host cell comprising the isolated polynucleotide of claim 17.

14. (previously presented) The isolated polynucleotide of claim 17 further encoding a functional domain selected from the group consisting of p300, CBP, PCAF, SRC1, P/CAF, ERF-2, OSGAL, HALF-1, C1, AP1, ARF-5, ARF-6, ARF-7, ARF-8, CPRF1, CPRF4, MYC-RP/GP, and TRAF1.

MPEP 803 discusses the two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and
- (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

Because the Office has already examined together in two separate Office actions on the merits, the subject matter which is now being restricted, the Office cannot establish a showing of serious burden. Without a showing of burden, restriction is not proper.

DECISION

For this reason, the petition filed under 37 CFR 1.144 is **GRANTED**.

The finality of the Office action mailed 16 May 2006 has been withdrawn. The application will be forwarded to the Examiner to consider papers filed since the final Office action and for action consistent with this decision.

Should there be any questions regarding this decision, please Quality Assurance Specialist/Program Manager Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.



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